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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,820	09/20/2001	David Thomas Davies		1047

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EXAMINER

WEDDINGTON, KEVIN E

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 04/10/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/889,820

Applicant(s)
Davies et al.

Examiner
Kevin E. Weddington

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1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 2, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) 2-11 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other: _____

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CLAIMS 1-13 ARE PRESENTED FOR EXAMINATION.

APPLICANTS' PRELIMINARY AMENDMENT AND INFORMATION DISCLOSURE STATEMENT FILED SEPTEMBER 20, 2001 HAVE BEEN RECEIVED AND ENTERED.

APPLICANTS' ELECTION FILED DECEMBER 2, 2002 IN RESPONSE TO THE RESTRICTION REQUIREMENT OF OCTOBER 29, 2002 HAS BEEN RECEIVED AND ENTERED. THE APPLICANTS ELECTED THE INVENTION DESCRIBED IN CLAIMS 1 AND 12 (GROUP I) WITH TRAVERSE, ALONG WITH ELECTED SPECIES, [3R,4R]-1-HEPTYL-3-(CARBOXYMETHYL)-4-[3-(6-METHOXYQUINOLIN-4-YL)PROPYL]PIPERIDINE.

APPLICANTS' TRAVERSE OF THE RESTRICTION REQUIREMENT IS NOT FOUND PERSUASIVE SINCE THE REJOINING OF THE TWO OTHER INVENTIONS WITH THE ELECTED INVENTION WOULD BE AN UNDUE BURDEN ON THE EXAMINER. FURTHER, EACH INVENTION IS CAPABLE OF SUPPORTING ITS OWN PATENT.

CLAIMS 2-11 AND 13 ARE WITHDRAWN FROM CONSIDERATION AS BEING DRAWN TO THE NON-ELECTED INVENTION (37 CFR 1.142(b)).

PRIORITY

RECEIPT IS ACKNOWLEDGED OF PAPERS SUBMITTED UNDER 35 U.S.C. 119(A)-(D), WHICH PAPERS HAVE BEEN PLACED OF RECORD IN THE FILE.

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ALLOWABLE SUBJECT MATTER

APPLICANTS' ELECTED SPECIES IS DEEMED ALLOWABLE BY THE EXAMINER.

CLAIM REJECTIONS - 35 U.S.C. § 102

THE FOLLOWING IS A QUOTATION OF THE APPROPRIATE PARAGRAPHS OF 35 U.S.C. 102 THAT FORM THE BASIS FOR THE REJECTIONS UNDER THIS SECTION MADE IN THIS OFFICE ACTION:

A PERSON SHALL BE ENTITLED TO A PATENT UNLESS -

(A) THE INVENTION WAS KNOWN OR USED BY OTHERS IN THIS COUNTRY, OR PATENTED OR DESCRIBED IN A PRINTED PUBLICATION IN THIS OR A FOREIGN COUNTRY, BEFORE THE INVENTION THEREOF BY THE APPLICANT FOR A PATENT.

CLAIM 12 IS REJECTED UNDER 35 U.S.C. 102(A) AS BEING ANTICIPATED BY FRANCE PATENT (L), HEREBY KNOWN AS RENAULT ET AL.

RENAULT ET AL. TEACH PIPERIDINE DERIVATIVES AND THEIR THERAPEUTIC USES (SEE THE ENCLOSED ABSTRACT). NOTE ONE OF THE PIPERIDINE DERIVATIVES, THE R GROUP IS 4-QUINAZOLINYL, WHICH INCLUDES ONE OF THE APPLICANTS' COMPOUNDS, 1-[2-(1,1-DIMEHTYLETHYL)-4-QUINAZOLINYL]-3-(4-PIPERIDINYL)-1-PROPANONE, AND IS FORMULATED INTO COMPOSITIONS. CLEARLY, THE CITED REFERENCE ANTICIPATES THE APPLICANTS' INSTANT COMPOSITION COMPRISING THE SAME COMPOUND. CLEARLY THE CITED REFERENCE TEACHES THE APPLICANTS' INSTANT COMPOSITION IS OLD AND WELL-KNOWN IN THE ART, THEREFORE, THE INSTANT COMPOSITION IS UNPATENTABLE.

CLAIM 12 IS NOT ALLOWED.

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CLAIM REJECTIONS - 35 U.S.C. § 103

THE FOLLOWING IS A QUOTATION OF 35 U.S.C. 103(A) WHICH FORMS THE BASIS FOR ALL OBVIOUSNESS REJECTIONS SET FORTH IN THIS OFFICE ACTION:

(A) A PATENT MAY NOT BE OBTAINED THOUGH THE INVENTION IS NOT IDENTICALLY DISCLOSED OR DESCRIBED AS SET FORTH IN SECTION 102 OF THIS TITLE, IF THE DIFFERENCES BETWEEN THE SUBJECT MATTER SOUGHT TO BE PATENTED AND THE PRIOR ART ARE SUCH THAT THE SUBJECT MATTER AS A WHOLE WOULD HAVE BEEN OBVIOUS AT THE TIME THE INVENTION WAS MADE TO A PERSON HAVING ORDINARY SKILL IN THE ART TO WHICH SAID SUBJECT MATTER PERTAINS. PATENTABILITY SHALL NOT BE NEGATED BY THE MANNER IN WHICH THE INVENTION WAS MADE.

THIS APPLICATION CURRENTLY NAMES JOINT INVENTORS. IN CONSIDERING PATENTABILITY OF THE CLAIMS UNDER 35 U.S.C. 103(A), THE EXAMINER PRESUMES THAT THE SUBJECT MATTER OF THE VARIOUS CLAIMS WAS COMMONLY OWNED AT THE TIME ANY INVENTIONS COVERED THEREIN WERE MADE ABSENT ANY EVIDENCE TO THE CONTRARY. APPLICANT IS ADVISED OF THE OBLIGATION UNDER 37 CFR 1.56 TO POINT OUT THE INVENTOR AND INVENTION DATES OF EACH CLAIM THAT WAS NOT COMMONLY OWNED AT THE TIME A LATER INVENTION WAS MADE IN ORDER FOR THE EXAMINER TO CONSIDER THE APPLICABILITY OF 35 U.S.C. 103© AND POTENTIAL 35 U.S.C. 102(E), (F) OR (G) PRIOR ART UNDER 35 U.S.C. 103(A).

CLAIM 1 IS REJECTED UNDER 35 U.S.C. 103(A) AS BEING UNPATENTABLE OVER RENAULT ET AL. (L).

RENAULT ET AL. WAS DISCUSSED ABOVE SUPRA FOR USE OF THE INSTANT PIPERIDINYLQUINOLINE COMPOUNDS IN PHARMACEUTICAL COMPOSITIONS.

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THE INSTANT INVENTION DIFFERS FROM THE CITED REFERENCE IN THAT THE CITED REFERENCE DOES NOT TEACH THE INSTANT PIPERIDINE DERIVATIVES ARE USED TO TREAT BACTERIAL INFECTIONS. HOWEVER, ONE SKILLED IN THE ART WOULD HAVE ASSUME THE INSTANT PIPERIDINE DERIVATIVES WOULD EFFECTIVE AGAINST BACTERIAL INFECTIONS SINCE THE DERIVATIVES OR COMPOUNDS POSSES THERAPEUTIC USES. CLEARLY, THE USE FOR TREATING BACTERIAL INFECTIONS IS A THERAPEUTIC FUNCTION, THEREFORE, THE USE OF THE INSTANT COMPOUNDS TO TREAT BACTERIAL INFECTION IS OBVIOUS IN THE ABSENCE OF EVIDENCE TO THE CONTRARY.

CLAIM 1 IS NOT ALLOWED.

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO EXAMINER K. WEDDINGTON WHOSE TELEPHONE NUMBER IS (703) 308-1235.

Kevin E. Weddington
Kevin E. Weddington
Primary Examiner
Art Unit 1614

K. WEDDINGTON

APRIL 6, 2003